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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,947

04/07/2006

Shinya Fukuta

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RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036

EXAMINER

SADIO, INSA

ART UNIT

PAPER NUMBER

2629

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,947	<b>Applicant(s)</b> FUKUTA, SHINYA	
	<b>Examiner</b> INSA SADIO	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/07/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claim 5** is rejected under 35 USC 101 claimed invention is directed to non-statutory subject matter. “A program to perform....a first detection... a second detection...” recited in claim 5 would reasonably be interpreted by one skill in the art as a software ,per se.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of claim 1, lines 2-4 “ a touch panel overlaid display **or** an operation using a remote control” and in lines 5-8 “first detecting means...using the remote control” , “second detecting means ...using the touch panel” is confusing. This

statement contradicts with the previous phrase above, because it is not clear that the user selects a touch panel or a remote control. Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 3 -5 are** rejected under 35 U.S.C. 102(b) as being unpatentable by Juen et al. (US Publication number 2001/0011992), hereinafter referenced as Juen.

**As of claim 1**, Juen discloses an Image processing apparatus and method. Jeun teaches wherein said An information processing apparatus for performing a process in accordance with an operation on a touch panel overlaid on a display or an operation using a remote control(see para [0022], [0052]), the apparatus comprising: first detecting means for detecting an operation using the remote control (see para [0083] “remote operation receiving unit”, Fig. 8 [44]); second detecting means for detecting an operation on the touch panel(see para [0039], “position input means”); and display control means for executing an indication to indicate a position specified by a user on a screen of the display in accordance with the operation using the remote control detected by the first detecting means(see para [0046], [0047], [0049] (please note that the remote control is identified here as the relative position)) and canceling the indication to indicate the position specified by the user on the screen of the display in accordance with the

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operation on the touch panel detected by the second detecting means(see para [0044], [0045], [0046], [0047] (process equivalent to that of the claimed invention)).

**As of claim 3**, Juen teaches the limitation of claim 1 above. Further, Juen teaches wherein said imaging means for capturing an image of an object to generate image signals corresponding to the object (see para [0010], [0058], [0059]); and recording and playback means for recording the image signals generated by the imaging means and playing back the signals (see para [0010], [0058], [0059]).

**Claim 4** is rejected the same as claim 1. The only difference is claim 4 is a method.

**Claim 5** is rejected the same as claim 1. The only difference is claim 5 is a program.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Juen in view of Boals et al. (US Publication number 2003/0146907), hereinafter referenced as Boals.

**As of claim 2**, Juen teaches the limitation of claim 1 above.

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Juendo not teach wherein said **timer means for timing non-operation time during which an operation using the remote Control is not performed, wherein when the non-operation time is continued for a predetermined period, the display control means cancels the indication to indicate the position specified by the user on the screen of the display.**

However, Boals teaches a timer that is turned off at suspend mode upon inactivity on the device (see para [0090], [0091], [0092], [0093], [0097] (process equivalent to the claimed invention)).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Juen's device with the teaching of Boals' timer, because this allows to avoid an operation on the device at the user's indiscretion.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to INSA SADIO whose telephone number is (571)270-5580. The examiner can normally be reached on MONDAY through FRIDAY 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amare Mengistu can be reached on 571-272-7674. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

INSA SADIO  
Examiner  
Art Unit 2629

/INSA SADIO/  
Examiner, Art Unit 2629  
/Amare Mengistu/  
Supervisory Patent Examiner, Art Unit 2629